



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,355	09/13/2004	Erica Tsai	60154.301803	5354

32112 7590 09/21/2005

INTELLECTUAL PROPERTY LAW OFFICE
1901 S. BASCOM AVENUE, SUITE 660
CAMPBELL, CA 95008

EXAMINER

WALSH, DANIEL I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No.		Applicant(s)	
	10/711,355		TSAI ET AL.	
	Examiner		Art Unit	
	Daniel I. Walsh		2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the IDS of 16 June 2005 and the Response of 30 June 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 8-11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. (US 2004/0076105) in view of Foote (US 4,041,279) and Desai (US 5,493,105).

King et al. teaches an information card with at least one stripe zone and a ring zone to contain magnetically recorded instances of the data (paragraph [0061] and FIG. 10A+).

Art Unit: 2876

King et al. is silent to a reader with a stationary read mechanism to read the data magnetically recorded in at least one of the zones by placing the information card proximate to the stationary read mechanism.

Foote teaches a stationary reader/read mechanism (col 1, lines 9+).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of King et al. with those of Foote.

One would have been motivated to do this to have an alternative (and conventional means) of reading magnetic strip cards by movement of the card and not the reader head/reader to reduce the wear and movement of the reader head itself.

King et al./Foote are silent to visual indicia on its front surface.

The Examiner notes that identifying indicia for identification on the front surface of a card (opposite to the magnetic strip) is well known and conventional (see conventional credit card, debit cards, drivers licenses, etc.). Specifically, Desai teaches a card with printed matter on one side and stored data on the other (FIG. 2A+). Re claims 8 and 15, the Examiner notes its well known and conventional for cards to be made out of plastic/paper for low cost production (also see Desai col 5, lines 59+). Re claim 11, Desai teaches that the card has encoded data such as the full name (col 5, lines 66+), and that the card also has printed data on it. Though silent to the printed data including the name of a user, the Examiner notes its well known and conventional to store the printed user name and other printed information of the card (name, account number, etc) in the memory means of the card itself, as such information being read and needed to facilitate a transaction/use of the card, and therefore is an obvious expedient.

Art Unit: 2876

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of King et al./Foote with those of Desai.

One would have been motivated to do this in order to provide identification information on the card, as is well known and conventional in the art.

Re claims 9-10, the limitations have been discussed above, as the zone contains the data.

3. Claims 2, 4, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al./Foote/Desai, further in view of Clark (US 6,370,241)

The teachings of King et al./Foote/Desai have been discussed above.

King et al./Foote/Desai are silent to one of the zones contains data and data identifiers associated with the data, and that the reader initiates an action automatically in response to reading the data identifier, wherein the reader includes a telephone device and the data includes a telephone number and the action is dialing the number.

Clark teaches "It should be noted that, in the event the calling card utilized comprises a magnetic strip, it may not be necessary for the calling cardholder to dial the predetermined calling card service number or enter a calling card account number. Rather, in such instances, card reader 18 at originating phone 10 will read an encoded calling card service number and calling card account number from the magnetic strip on the calling card and automatically utilize such data to initiate a call to predetermined calling switch 22 (e.g., with the calling card account number being transmitted to switch 22 and manger 32 with such call)" (col 5, lines 7+). This is interpreted to include the reader include a telephone device, and that the card includes data in the magnetic strip, where the data includes a phone number, and that the number is automatically dialed. Though Clark is silent to the use of "data identifiers" at the time the invention was made,

Art Unit: 2876

it would have been obvious to an artisan of ordinary skill in the art to include data identifiers that evoke automatic responses when read, because it has already been taught above to automatically dial a phone in response to reading the card, and therefore having data identifiers would be an obvious expedient as a way to help organize/manage data that initiates automatic responses. Further, it is understood that a data identifier of some sort would necessarily be included so that the automatically dialing of a pre-stored service number could be completed by only swiping the card through the reader, as it is well known that data identifiers of cards are commonplace since they permit data such as the account number to be recorded/stored regarding a transaction.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of King et al./Foote/Desai with those of Clark.

One would have been motivated to do this to make a system that is more convenient for the user by automatically dialing a phone in response to a card swipe.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over King et al./Foote/Desai/Clark, as discussed above, in view of Vatanen (US 6,169,890).

The teachings of King et al./Foote/Desai/Clark have been discussed above.

King et al./Foote/Desai/Clark are silent to the reader including a database of records having a plurality of uniquely identifier fields, and the action is storing instances of the data into the uniquely identified fields of the records when the data identifiers associated with the data match the uniquely identified fields.

It is well known in the art to store data in database fields when the identifiers of the data match the fields. Such practice is common in inventory, ATM machines, etc., where data is scanned/read and the fields of the database are updated accordingly (as the identifiers match the

Art Unit: 2876

fields, thus ensuring the correct information is stored in the correct field). Further, Vatanen teaches "the charging of calls when using a certain service data terminal having a credit card reader. In the credit card phone method, a local database, storage and a programming intelligence have been connected to the telephone to enable the processing of calls. In that method, the user enters the credit card number after having dialed the required number, the data is locally recorded after having checked the authenticity of the card, and if the authorization succeeds, the call set-up continues. The line is supervised during the call. The card number, the dialed number, the date, time and call time are locally recorded, and the host computer is updated with this information." (col 2, lines 5+). Hence, Vatanen teaches the local storing of the card data, and updating, but is silent to where the updating takes place (local or remote). However, at the time the invention was made, it would have been an obvious matter of design variation to have the database be remote or local. One would have been motivated to do this in order to accommodate the specific need of the system; i.e. if the card reader is a stand alone unit (not networked) it would be obvious for the storage to be local, and for the storage to be updated locally, since the unit is self contained, thereby not needing an external connection.

Therefore at the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of King et al./Foote/Desai/Clark with those of Vatanen in order to have a unit with a local data storage, so that the data storage unit is self contained and does not have to rely on an external connection.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over King et al./Foote/Desai/Clark, as discussed above, in view of Palomo et al. (US 6,405,126).

The teachings of King et al./Foote/Desai/Clark have been discussed above.

King et al./Foote/Desai/Clark fail to teach that the reader includes a GPS device and display, and that the data includes GPS data, and that the action is displaying a map or route on the display unit based on the data.

Palomo et al. teaches "A system and method for finding an intended destination using an in-vehicle navigation system. Intended destinations are received and are coupled to an in-vehicle navigation system using various methods. In one embodiment, the intended destinations are stored on a magnetic strip that is disposed on the back of a plastic card. The plastic card is inserted into the in-vehicle navigation system where the data on the magnetic strip is read. Alternatively, a transmitter/receiver system is used to transmit the intended destinations to the in-vehicle navigation system. Once the intended destinations are coupled to the in-vehicle navigation system, the user is able to find an intended destination by selecting the desired intended destination from a list displayed by the in-vehicle navigation system. The in-vehicle navigation system then determines the current location of the vehicle and indicates how to find the intended destination using a moving map display and/or verbal instructions" (abstract). This is interpreted to include a GPS device and display, since the navigation system of Palomo is interpreted as a GPS system. Further, the data on the card is GPS data since they are intended destinations. Accordingly, inserting of the card leads to displaying a map or route by indicating how to reach the destination through a moving map display.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of King et al./Foote/Desai/Clark with those of Palomo et al.

One would have been motivated to do this in order to have a GPS system that is responsive to a card, so that GPS data can be easily transported into a GPS device for locating a desired location; this increases the usability and convenience of the device for the user.

6. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al./Foote/Desai, as applied to claim 1 above, further in view of Kamo et al. (US 5,942,744).

The teachings of King et al./Foote/Desai have been discussed above.

King et al./Foote/Desai are silent to one of the zones including a data orientator to permit reading the data regardless of the orientation of the card relative to the stationary reader.

Kamo et al. teaches that the magnetic card can be inserted any way and still read based on address information stored on the tracks (interpreted as data orientators) (col 39, lines 58+).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of King et al./Foote/Desai with those of Kamo et al.

One would have been motivated to do this in order to permit reading of the card regardless of insertion direction, for user convenience.

7. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al./Foote/Desai, as discussed above, in view of Marappan (US 2003/0205615).

The teachings of King et al./Foote/Desai have been discussed above.

King et al./Foote/Desai are silent to the zone including data in an xml format (extensible markup language tagging).

Marappan teaches the magnetic card is stored in XML format/tagging (abstract)

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of King et al./Foote/Desai with those of Marappan.

One would have been motivated to do this to have a card that is readable by many different readers (compatibility and ease of reading/processing the card).

Response to Arguments

8. In response to the Applicants argument that King is not prior art, the Examiner disagrees. The Examiner notes that the current application is a CIP of US 10/371,928 which is a divisional of US 09/835,961. Accordingly, as US 10/371,928 is silent to a stationary read mechanism as currently recited, the claims do not gain benefit of the earlier filed application. Accordingly, King does qualify as prior art.

9. In response to the Applicants argument that the teachings of Foote are not enabling teachings, the Examiner notes that Foote establishes that such readers/reading means are known/conventional.

10. Re the Applicants arguments of claims 2, 4, and 12, the Examiner maintains his rejection and notes that his interpretation of a data identifier is a reasonable interpretation.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
9-5-05

A handwritten signature in black ink, appearing to read 'Karl D. Frech', with a stylized, flowing script.

KARL D. FRECH
PRIMARY EXAMINER